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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/688,430  
Filing Date: October 17, 2003  
Appellant(s): AALTONEN ET AL.

Phouphanomketh Ditthavong (Reg. No. 44658)

For Appellant

**EXAMINER'S ANSWER**

1. This is in response to the appeal brief filed 3/2/2011 appealing from the Office action mailed 9/2/2010.

**Real Party in Interest**

2. The appellants' statement identifying the real party in interest contained in the brief is correct.

**Related Appeals and Interferences**

3. The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**Status of Claims**

4. The appellants' statement of the status of claims contained in the brief is correct.

**Status of Amendments**

5. The appellants' statement of the status of amendments after contained in the brief is correct.

**Summary of Claimed Subject Matter**

6. The appellants' summary of claimed subject matter contained in the brief is correct.

**Grounds of Rejection to be Reviewed on Appeal**

7. The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**Claims Appendix**

8. The appellants' copy of the appealed claims contained in the Appendix to the brief is correct.

**Evidence Relied Upon**

|           |                  |        |
|-----------|------------------|--------|
| 5,798,785 | Hendricks et al. | 8-1998 |
| 6,788,658 | Bims             | 9-2004 |
| 6,785,539 | Hale             | 8-2004 |

**Grounds of Rejection**

9. The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 8-25, 27-42, 44-59, and 61-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner does not find proper descriptions for the new limitations "a terminal configured to determine to access", "the terminal is also configured to determine to store", "a trigger to the terminal to determine to obtain its location", "determining to access at least one piece of content from a memory of a terminal in an offline...", etc., in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These "determine to" limitations are recited all over the independent and dependent claims. However, there is no algorithm is recited, and/or no processor/ "entity" is recited for the corresponding determination. Note that the specification only provides descriptions on "determine the location of the terminal".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 11-16, 18-19, 29-34, 36, 46-51, 53, 63-68, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US 5,798,785, hereinafter Hendricks), and in view of Bims (US 6,788,658 B1, hereinafter Bims).**

Regarding claim 11, Hendricks discloses a system comprising:

a terminal configured to access at least one piece of content from a memory (220 Set top terminal FIG. 3 and col. 9 line 21 through col. 10 line 62 ) , wherein the at least one piece of content comprises at least one piece of pre-broadcast content (FIG. 14 and col. 38, lines 24-28, preview menu. Note that page 26, lines 4-11 of the original specification indicated previews are one of pre-broadcast content) related to broadcast content, the pre-broadcast content including the broadcast content, wherein the terminal is also configured to store, into a content usage log, at least one content usage statistic relating to the terminal accessing the at least one piece of pre-broadcast content from the memory (col. 9 line 21 through col. 10 line 62, local storage); and

a destination configured to receive the content usage log including the at least one content usage statistic before the broadcast content is broadcast (202 Operations Center Fig. 3, col. 9, lines 11-19, and col. 38, lines 24-28, preview menu).

Hendricks discloses the claimed invention except for: determine to access and determine to store. However, "determining" as one of the actions and processes of a computer system or similar electronic computing device is well known in the art as evidenced by Bims (see at least col. 3, lines 28-41). Bims further discloses a repeater determines if it is to send the acknowledgement packet (see at least col. 5, lines 51-58). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Bims' teaching into Hendricks' system for the purpose of automatically making decision by configuring terminals to determine to access and determine to store, thereby enabling one of the actions and processes of a

computer system or similar electronic computing device (see at least col. 3, lines 28-41).

Regarding claim 12, Hendricks further discloses wherein the terminal is configured to receive the at least one piece of content in accordance with a broadband data broadcast technique (col. 9, lines 50-59), and wherein the at least one piece of content comprises at least one piece of content for at least one channel comprising at least one of a television, radio or data channel (col. 10, lines 25-31).

Regarding claim 13, Hendricks and Bims further disclose wherein the terminal is configured to determine to send the content usage log to the destination when a return channel between the terminal and the destination is at least one of available or established (col. 13 line 56 through col. 14 line 6. Note that cable headend 208 communicates with operation center 202 or statistical and billing sites). See claim 11 for motivation.

Regarding claim 14, Hendricks further discloses wherein the at least one content usage statistic comprises at least one statistic related to at least one of the terminal and the at least one piece of content accessed from the memory (col. 10, lines 13-24).

Regarding claim 15, Hendricks further discloses wherein the terminal is configured to access at least one piece of content from a memory of the terminal in an offline manner (col. 9 line 21 through col. 10 line 62).

Regarding claim 16, Hendricks and Bims further disclose wherein the terminal is configured to: determine to repeatedly access at least one piece of content and determine to repeatedly store at least one content usage statistic for a period of time

before the broadcast content is broadcast, and determine to send the content usage log to the destination after the period of time and before the broadcast content is broadcast (col. 13 line 56 through col. 14 line 6; col. 15, lines 55-65). See claim 11 for motivation.

Regarding claim 18, Hendricks further discloses wherein the destination (a viewing information server) is configured to receive the content usage log including the at least one content usage statistic such that a network entity is configured to send, to the terminal, at least one piece of content based upon the at least one content usage statistic (col. 29, lines 26-43).

Regarding claim 19, Hendricks further discloses wherein the at least one content usage statistic comprises at least one of the following relating to the at least one piece of content accessed from the memory, a time the at least one piece of content was accessed from memory, information regarding used connection types, or information regarding available connection types comprising at least one of a signal strength, capacity or utilization rate of the connection types (col. 7, lines 15-29, capacity improvement).

Regarding claim 29, Hendricks discloses an apparatus comprising:  
at least one processor; and at least one memory including computer program code for one or more programs (220 Set top terminal FIG. 3 and col. 9 line 21 through col. 10 line 62), the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to perform at least the following,

access at least one piece of content from a memory (220 Set top terminal FIG. 3 and col. 9 line 21 through col. 10 line 62), the at least one piece of content comprising at



least one piece of pre-broadcast content related to broadcast content, the pre-broadcast content including the broadcast content (FIG. 14 and col. 38, lines 24-28, preview menu. Note that page 26, lines 4-11 of the original specification indicated previews are one of pre-broadcast content),

store, into a content usage log (col. 9 line 21 through col. 10 line 62), at least one content usage statistic relating to accessing the at least one piece of pre-broadcast content from the memory, and

send the content usage log to a destination before the broadcast content is broadcast (202 Operations Center Fig. 3, col. 9, lines 11-19, and col. 38, lines 24-28, preview menu).

Hendricks discloses the claimed invention except for: determine to access, determine to store, and determine to send. However, "determining" as one of the actions and processes of a computer system or similar electronic computing device is well known in the art as evidenced by Bims (see at least col. 3, lines 28-41). Bims further discloses a repeater determines if it is to send the acknowledgement packet (see at least col. 5, lines 51-58). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Bims' teaching into Hendricks' system for the purpose of automatically making decision by configuring terminals to determine to access, determine to store, and determine to send, thereby enabling one of the actions and processes of a computer system or similar electronic computing device (see at least col. 3, lines 28-41).

Regarding claim 30, Hendricks further discloses wherein the apparatus is further caused to receive the at least one piece of content in accordance with a broadband data broadcast technique (col. 9, lines 50-59), wherein the at least one piece of content comprises at least one piece of content for at least one channel comprising at least one of a television, radio or data channel (col. 10, lines 25-31).

Regarding claim 31, Hendricks and Sims further disclose wherein the apparatus is further caused to determine to send the content usage log to the destination when a return channel between the apparatus and the destination is at least one of available or established (col. 13 line 56 through col. 14 line 6. Note that cable headend 208 communicates with operation center 202 or statistical and billing sites). See claim 29 for motivation.

Regarding claim 32, Hendricks further discloses wherein the at least one content usage statistic comprises at least one statistic related to at least one of the apparatus and the at least one piece of content accessed from the memory of the apparatus (col. 10, lines 13-24).

Regarding claim 33, Hendricks and Sims further disclose wherein the apparatus is further caused to determine to access the at least one piece of content from a memory of a apparatus in an offline manner (col. 9 line 21 through col. 10 line 62). See claim 29 for motivation.

Regarding claim 34, Hendricks and Bims further disclose wherein the apparatus is further caused to: determine to repeatedly access the at least one piece of content, determine to repeatedly store the at least one content usage statistic for a period of time

before the broadcast content is broadcast, and determine to send the content usage log to the destination after the period of time and before the broadcast content is broadcast (col. 13 line 56 through col. 14 line 6; col. 15, lines 55-65). See claim 29 for motivation.

Regarding claim 36, Hendricks further discloses wherein the at least one content usage statistic comprises at least one of the following relating to the at least one piece of content accessed from the memory, a time the at least one piece of content was accessed from memory, information regarding used connection types, or information regarding available connection types comprising at least one of a signal strength, capacity or utilization rate of the connection types (col. 7, lines 15-29, capacity improvement).

Claims 46-51, 53 are of the same scope as claims 11-16, and 19 respectively. They are rejected for the same reasons as for claims 11-16, and 19 respectively.

Claims 63-68, 70 are of the same scope as claims 11-16, and 19 respectively. They are rejected for the same reasons as for claims 11-16, and 19 respectively.

**Claims 1-4, 6, 8-10, 20-23, 25, 27-28, 37-40, 42, 44-45, 54-57, 59, 61-62, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US 5,798,785, hereinafter Hendricks), in view of Bims (US 6,788,658 B1, hereinafter Bims), and further in view of Hale et al. (US 6,785,539, hereinafter Hale).**

Regarding claim 1, Hendricks discloses a system comprising:

a terminal configured to access at least one piece of content from a memory of the terminal in an offline manner after receipt of the at least one piece of content, wherein the terminal is also configured to store, into a content usage log, at least one content usage statistic relating to the access of the at least one piece of content from memory, and wherein at least one content usage statistic comprises the location of the terminal (220 Set top terminal FIG. 3 and col. 9 line 21 through col. 10 line 62; address field 924 FIG. 7b ; col. 15, lines 55-65); and

a destination configured to receive the content usage log including the at least one content usage statistic (202 Operations Center Fig. 3 and col. 9, lines 11-19).

Hendricks discloses the claimed invention except for: determine to access, determine to obtain, and determine to store. However, "determining" as one of the actions and processes of a computer system or similar electronic computing device is well known in the art as evidenced by Bims (see at least col. 3, lines 28-41). Bims further discloses a repeater determines if it is to send the acknowledgement packet (see at least col. 5, lines 51-58). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Bims' teaching into Hendricks' system for the purpose of automatically making decision by configuring terminals to determine to access, determine to obtain, and determine to store, thereby enabling one of the actions and processes of a computer system or similar electronic computing device (see at least col. 3, lines 28-41).

Hendricks and Bims disclose substantially all the limitations in claim 1, but fails to teach the access of the at least one piece of content being a trigger to the terminal to obtain its location, the terminal being configured to obtain its location in response to the trigger. However, Hale teaches a portable device used to automatically store usage patterns. The stored information may be used for tracking user preferences, may be used to infer user location and direction. The information gathered from many devices may be collected in a database. The data may be analyzed to determine group behavior, identify popular locations (col. 10, lines 35-67). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Hale's teaching into Hendricks' and Bims' system for the purpose of tracking locations of terminals by triggering terminals to obtain their locations when access a piece of content, thereby collecting useful usage patterns and location related information.

Regarding claim 2, Hendricks further discloses wherein the terminal is configured to receive the at least one piece of content in accordance with a broadband data broadcast technique (col. 9, lines 50-59), and wherein the at least one piece of content comprises at least one piece of content for at least one channel comprising at least one of a television, radio or data channel (col. 10, lines 25-31).

Regarding claim 3, Hendricks and Bims further disclose wherein the terminal is configured to determine to send the content usage log to the destination when a return channel between the terminal and the destination is at least one of available or established (col. 13 line 56 through col. 14 line 6. Note that cable headend 208

communicates with operation center 202 or statistical and billing sites). See claim 1 for motivation.

Regarding claim 4, Hendricks and Bims further disclose wherein the terminal is configured to determine to access at least one piece of content comprising at least one piece of pre-broadcast content related to broadcast content, and wherein the terminal is configured to determine to send the content usage log to the destination before the broadcast content is broadcast (FIG. 14 and col. 38, lines 24-28, preview menu. Note that page 26, lines 4-11 of the original specification indicated previews are one of pre-broadcast content; col. 9, lines 11-19). See claim 1 for motivation.

Regarding claim 6, Hendricks further discloses wherein the at least one content usage statistic comprises at least one statistic related to at least one of the terminal and the at least one piece of content accessed from the memory (col. 10, lines 13-24).

Regarding claim 8, Hendricks and Bims further disclose wherein the terminal is configured to determine to repeatedly access at least one piece of content, each access being a trigger to the terminal to determine to obtain its location; determine to obtain its location in response to each respective trigger; determine to repeatedly store at least one content usage statistic for at least one period of time, and determine to send the content usage log to the destination after each period of time (col. 13 line 56 through col. 14 line 6; col. 15, lines 55-65). See claim 1 for motivation.

Regarding claim 9, Hendricks and Bims further disclose wherein the destination is configured to receive the content usage log including the at least one content usage statistic such that a network entity is configured to determine to send, to the terminal, at

least one piece of content based upon the at least one content usage statistic (col. 29, lines 26-43). See claim 1 for motivation.

Regarding claim 10, Hendricks further discloses wherein the at least one content usage statistic comprises at least one of the following relating to the at least one piece of content accessed from the memory, a time the at least one piece of content was accessed from memory, information regarding used connection types, or information regarding available connection types comprising at least one of a signal strength, capacity or utilization rate of the connection types (col. 7, lines 15-29, capacity improvement).

Regarding claim 20, Hendricks discloses an apparatus comprising:  
at least one processor; and at least one memory including computer program code for one or more programs (220 Set top terminal FIG. 3 and col. 9 line 21 through col. 10 line 62), the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to perform at least the following,

access at least one piece of content from a memory in an offline manner after receipt of the at least one piece of content (col. 10, lines 13-24), and

store, into a content usage log, at least one content usage statistic relating to the accessing of the at least one piece of content from memory into a content usage log, wherein the at least one content usage statistic comprises the location of the apparatus (col. 9 line 21 through col. 10 line 62; address field 924 FIG. 7b, col. 15, lines 55-65;).

Hendricks discloses the claimed invention except for: determine to access, determine to store, and determine to obtain. However, "determining" as one of the

actions and processes of a computer system or similar electronic computing device is well known in the art as evidenced by Bims (see at least col. 3, lines 28-41). Bims further discloses a repeater determines if it is to send the acknowledgement packet (see at least col. 5, lines 51-58). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Bims' teaching into Hendricks' system for the purpose of automatically making decision by configuring terminals to determine to access, determine to store, and determine to obtain, thereby enabling one of the actions and processes of a computer system or similar electronic computing device (see at least col. 3, lines 28-41).

Hendricks and Bims disclose substantially all the limitations in claim 20, but fails to teach the access of the at least one piece of content being a trigger to the controller to obtain a location of the apparatus, the controller being configured to obtain the location of the apparatus in response to the trigger. However, Hale teaches a portable device used to automatically store usage patterns. The stored information may be used for tracking user preferences, may be used to infer user location and direction. The information gathered from many devices may be collected in a database. The data may be analyzed to determine group behavior, identify popular locations (col. 10, lines 35-67). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Hale's teaching into Hendricks' and Bims' system for the purpose of tracking locations of apparatus by triggering apparatus to obtain their locations when access a piece of content, thereby collecting useful usage patterns and location related information.



Regarding claim 21, Hendricks further discloses wherein the apparatus is further caused to receive the at least one piece of content in accordance with a broadband data broadcast technique (col. 9, lines 50-59), wherein the at least one piece of content comprises at least one piece of content for at least one channel comprising at least one of a television, radio or data channel (col. 10, lines 25-31).

Regarding claim 22, Hendricks and Bims further disclose wherein the apparatus is further caused to determine to send the content usage log to the destination when a return channel between the terminal and the destination is at least one of available or established (col. 13 line 56 through col. 14 line 6. Note that cable headend 208 communicates with operation center 202 or statistical and billing sites). See motivation in claim 20.

Regarding claim 23, Hendricks and Bims further disclose wherein the apparatus is further caused to receive and store at least one piece of content comprising at least one piece of pre-broadcast content related to broadcast content, determine to send the content usage log to a destination before the broadcast content is broadcast (FIG. 14 and col. 38, lines 24-28, preview menu. Note that page 26, lines 4-11 of the original specification indicated previews are one of pre-broadcast content; col. 9, lines 11-19). See motivation in claim 20.

Regarding claim 25, Hendricks further discloses wherein the at least one content usage statistic comprises at least one statistic related to at least one of the apparatus or the at least one piece of content accessed from the memory of the apparatus (col. 10, lines 13-24).

Regarding claim 27, Hendricks, Bims, and Hale further disclose wherein the apparatus is further caused to: determine to repeatedly access the at least one piece of content, each access being a trigger to determine to obtain the location of the apparatus, determine to obtain the location of the apparatus in response to each respective trigger, determine to repeatedly store the at least one content usage statistic for at least one period of time, and determine to send the content usage log to a destination after each respective period of time (col. 13 line 56 through col. 14 line 6; col. 15, lines 55-65). See claim 20 for motivation.

Regarding claim 28, Hendricks further discloses wherein the at least one content usage statistic comprises at least one of the following relating to the at least one piece of content accessed from the memory, a time the at least one piece of content was accessed from memory, information regarding used connection types, or information regarding available connection types comprising at least one of a signal strength, capacity or utilization rate of the connection types (col. 7, lines 15-29, capacity improvement).

Claims 37-39, 42, 44-45 are of the same scope as claims 1-3, 6, 8, and 10 respectively. They are rejected for the same reasons as for claims 1-3, 6, 8, and 10 respectively.

Claims 40 and 57 are of the same scope as claim 4. They are rejected for the same reasons as for claim 4.

Claims 54-56, 59, 61-62 are of the same scope as claims 1-3, 6, 8, and 10 respectively. They are rejected for the same reasons as for claims 1-3, 6, 8, and 10 respectively.

Regarding claim 71, Hendricks further discloses wherein the location of the apparatus includes a geographic location of the apparatus (col. 16, lines 4-15).

**Claims 5, 24, 41, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US 5,798,785, hereinafter Hendricks) in view of Bims (US 6,788,658 B1, hereinafter Bims) and Hale et al. (US 6,785,539, hereinafter Hale), and further in view of Inoue et al. (US 5,826,168, hereinafter Inoue).**

Regarding claim 5, Hendricks, Bims, and Hale fail to disclose the limitations. However, Inoue teaches wherein the at least one piece of pre-broadcast content comprises a set of at least one television program over a given time period for at least one television channel (FIG. 2B), wherein the terminal is configured to access the at least one piece of pre-broadcast content at least a predefined period of time before the broadcast content is broadcast (T1 FIG. 2B), and wherein the predefined period of time comprises the given time period (17 minutes FIG. 2B). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Inoue's teaching into Hendricks', Bims', and Hale's system for the purpose of accommodating the viewing schedule of a user by buffering the display of video signals

transmitted by a broadcaster, thereby providing a true near video-on-demand service (col. 2, lines 47-50).

Regarding claim 24, Hendricks, Bims, and Hale fail to disclose the limitations. However, Inoue teaches wherein the at least one piece of pre-broadcast content comprises a set of at least one television program over a given time period for at least one television channel (FIG. 2B), wherein the terminal is configured to access the at least one piece of pre-broadcast content at least a predefined period of time before the broadcast content is broadcast (T1 FIG. 2B), and wherein the predefined period of time comprises the given time period (17 minutes FIG. 2B). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Inoue's teaching into Hendricks', Bims', and Hale's system for the purpose of accommodating the viewing schedule of a user by buffering the display of video signals transmitted by a broadcaster, thereby providing a true near video-on-demand service (col. 2, lines 47-50).

Claims 41 and 58 are of the same scope as claim 5. They are rejected for the same reasons as for claim 5.

**Claims 17, 35, 52, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US 5,798,785, hereinafter Hendricks) in view of Bims (US 6,788,658 B1, hereinafter Bims), and further in view of Inoue et al. (US 5,826,168, hereinafter Inoue).**

Regarding claim 17, Hendricks and Bims fail to disclose the limitations.

However, Inoue teaches wherein the at least one piece of pre-broadcast content comprises a set of at least one television program over a given time period for at least one television channel (FIG. 2B), wherein the terminal is configured to access the at least one piece of pre-broadcast content at least a predefined period of time before the broadcast content is broadcast (T1 FIG. 2B), and wherein the predefined period of time comprises the given time period (17 minutes FIG. 2B). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Inoue's teaching into Hendricks' and Bims' system for the purpose of accommodating the viewing schedule of a user by buffering the display of video signals transmitted by a broadcaster, thereby providing a true near video-on-demand service (col. 2, lines 47-50).

Regarding claim 35, Hendricks and Bims fail to disclose the limitations.

However, Inoue teaches wherein the at least one piece of pre-broadcast content comprises a set of at least one television program over a given time period for at least one television channel (FIG. 2B), wherein the terminal is configured to access the at least one piece of pre-broadcast content at least a predefined period of time before the broadcast content is broadcast (T1 FIG. 2B), and wherein the predefined period of time comprises the given time period (17 minutes FIG. 2B). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Inoue's teaching into Hendricks' and Bims' system for the purpose of accommodating the viewing schedule of a user by buffering the display of video signals transmitted by a

broadcaster, thereby providing a true near video-on-demand service (col. 2, lines 47-50).

Claims 52 and 69 are of the same scope as claim 17. They are rejected for the same reasons as for claim 17.

### **Response to Arguments**

#### **A. Objection to Claims 20 and 29**

The examiner agrees with Appellant's statement to correct the specified informalities upon an indication of allowance or allowability.

**B. The Rejection of Claims 1-6, 8-25, 27-42, 44-59 and 61-71 Under 35 U.S.C. § 112, First Paragraph, is Improper Because the Specification Contains Adequate Descriptive Support for the Elements "Determine/ing to Access," "Determine/ing to Store," And "Determine/ing to Obtain," as Recited in the Rejected Claims.**

The examiner disagrees with Appellant's characterization (i.e. "[i]n other words, the processor, under execution of the associated software applications, "determines to" cause the entity to perform the associated method step or apparatus function. See page 11). For example, method claim 37 recites "determining to access at least one piece of content from a memory of a terminal in an offline..." Plain and simple the step requires a determination to access. However, no processor is recited, no algorithm is recited, no "entity" is recited. For another example, system claim 1 recites "a terminal configured to determine to access at least one piece of content from a memory of the

terminal in an offline..." Plain and simple the terminal requires a determination to access. However, no algorithm is recited.

It's unreasonable and in violation of the mandate to apply BRI and one can not read the specification into the claim, particularly, to read into the claims "the processor, under execution of the associated software applications, "determines to" cause the entity to perform the associated method step or apparatus function", as applicant argues.

**C. Claims 11-16, 18-19, 29-34, 36, 46-51, 53, 63-68 and 70 are Not Rendered Obvious by Hendricks In View Of Bims, Because the Cited References, Either Alone or in Combination, Fail to Disclose the Feature of Sending/Receiving the Content Usage Log Before the Broadcast Content is Broadcast, in the Manner as Recited by Independent Claims 11, 29, 46 and 63**

The examiner disagrees. Hendricks discloses a preview menu screen 1142 as shown in FIG. 14 may be shown to the subscriber which describes and previews the program selection. The preview menu screens may include live video or stills 1144 depicting the program selected (see column 38, lines 24-28). According to page 26, lines 4-11 of the original specification, previews are one of pre-broadcast content. Hendricks further discloses the local cable company will in turn be in communication with the operations center 202 or a regional control center (i.e., the destination in the claims) which accumulates return data from the set top terminal 220 (i.e., the terminal in the claims) for statistical or billing purposes (see column 9, lines 11-19). Therefore, Hendricks clearly discloses the feature of sending/receiving the content usage log

before the broadcast content is broadcast as recited by independent claims 11, 29, 46 and 63.

In response to Appellant's statement "the Examiner does not even allege that Hendricks discloses sending or receiving the content usage log before the broadcast content is broadcast in the 9/2/2010 Final Office Action" (see page 12), the Examiner admitted making a typo error by missing the phrase "before the broadcast content is broadcast".

**D. Claims 1-4, 6, 8-10, 20-23, 25, 27-28, 37-40, 42, 44-45, 54-57, 59, 61-62 and 71 are Not Rendered Obvious by Hendricks in View of Bims, and Further in View of Hale, Because the Cited References, Either Alone or in Combination, Fail to Disclose the Feature the Claimed Features Whereby the Terminal Accesses Content From Memory in an Offline Manner, and That the Access of the Content Serves as a Trigger for the Terminal to Determine its Location, in the Manner as Recited by Independent Claims 1, 20, 37 and 54**

The examiner disagrees. These claims recite limitations of "determine/ing to access", "determine/ing to send", "determine/ing to store", and/or "determine/ing to obtain." As discussed in Section B, no algorithm is recited, no processor is recited, or no "entity" is recited to support a determination to access, a determination to obtain, a determination to send, a determination to store, in these claims.

Furthermore, as Appellant indicated in pages 18-19, Hale discloses that a portable device receives a code from a particular transmitter at a venue location, and the code triggers the device to access a particular piece of content from memory (the



location triggers to access a corresponding content). One of ordinary skill in the art at the time the invention was made will have no problem to come up with the feature of: a terminal accesses at least one piece of content from memory, where the access of the at least one piece of content provides a trigger to the terminal to determine its location, as presently claimed. Since it has been held that a mere reverse of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

In response to Appellant's argument that Hale essentially is accessing the content in an on-line manner, Hale accesses the content from the portable device (see at least the abstract). According to paragraph [0006] of the specification, an offline use is, e.g., storing audio and/or video for subsequent access and presentation by the mobile terminal. Hale clearly meets the requirement of "offline manner".

In view of the foregoing, it is evident that the claimed features whereby the terminal accesses content from memory in an offline manner, and that the access of the content serves as a trigger for the terminal to determine its location, in the manner as recited by independent claims 1, 20, 37 and 54 are obvious under 35 U.S.C. 103(a) as being unpatentable over Hendricks in View of Bims, and Further in View of Hale.

**E. Claims 5, 24, 41 and 58 are Not Rendered Obvious by Hendricks in View of Bims and Hale, and Further in View of Inoue, Because the Additionally Cited Reference, Inoue, Fails to Cure the Foregoing Deficiencies of Hendricks in View of Bims and Hale (as presented in Section D, above)**

See response in Section D.

**F. Claims 17, 35, 52 and 69 are Not Rendered Obvious by Hendricks in View of Bims, and Further in View of Inoue, Because the Additionally Cited Reference, Inoue, Fails to Cure the Foregoing Deficiencies of Hendricks in View of Bims (as presented in Section C, above)**

See response in Section C.

**Related Proceeding(s) Appendix**

10. There are no copies of any decisions rendered by a court or the Board in any proceedings.
11. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael C. Lai

May 17, 2011

Conferees:

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Examiner, Art Unit 2457

/YVES DALENCOURT/

Primary Examiner, Art Unit 2457

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Application/Control Number: 10/688,430

Page 27

Art Unit: 2457

Supervisory Patent Examiner, Art Unit 2457